

**REMARKS**

This paper is filed responsive to the Office Action mailed April 10, 2009. Claims 1-18 are pending in the application. Claims 1-14 are amended to more clearly define the claimed invention; claims 15-18 are new. No new matter has been added.

Claims 1-9,11 and 14 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,548,837 (Petersen). Applicants traverse the rejection.

Claim 1 has been amended to more clearly define the claimed invention. Claim 1 claims:

An instrument for positioning a cup component of an orthopaedic joint prosthesis, the cup component having a mouth and an inner surface with a circumferential groove, the instrument comprising:

a shaft having a shaft axis and a distal end;

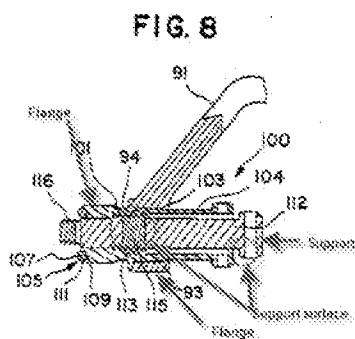
a housing attached to the distal end of the shaft, the housing extending from the shaft transversely relative to the shaft axis, the housing comprising a base plate; and

a flange portion carried on the shaft, the flange portion being configured to be movable relative to the base plate in a direction transverse to the shaft axis between an in-use position, where the flange portion is received in the groove of the cup component, and a retracted position where the flange portion is moved towards the shaft axis so as to allow the cup component to be released from the instrument, and wherein the flange portion is biased towards the in-use position.

Applicants submit that Peterson fails to disclose each element of the claimed invention and thus does not anticipate claim 1. Specifically, Peterson does not depict, among other claimed elements: a housing attached to the distal end of the shaft, the housing ***extending from the shaft transversely relative to the shaft axis***; a flange portion carried on the shaft, the flange portion ***being configured to be movable relative to the base plate in a direction transverse to the shaft***

*axis* between an in-use position, *where the flange portion is received in the groove of the cup component*, and a *retracted position where the flange portion is moved towards the shaft axis* so as to allow the cup component to be released from the instrument, and *wherein the flange portion is biased towards the in-use position*. In other words, Peterson does not depict much of what is claimed in amended claim 1.

Instead, Peterson depicts embodiments of a cup impactor that simply relies on a threaded portion of the impactor to screw into a cup. The threaded aspect is referred to as the “threaded portion 49” (Figs 3 and 4), the “threaded surface” or “threaded proximal end 63” (Figure 5),<sup>1</sup> and the “threaded portion 116” (Figure 8). Thus, the mechanism for engaging the cup in Peterson is nothing like that claimed in claim 1. As a result it is difficult to interpret any embodiment of Peterson to read on claim 1. The second embodiment focused on in the Office Action, depicted in Figure 8 (copied below from page 4 of the Office Action), does not contain the structure claimed in claim 1. The second Peterson embodiment (Figures 5-9) includes a shaft 81 that is bent at its distal end (see Figure 7) and terminates with a u-shaped component (see Figure 9). The u-shaped component is configured to accept a sleeve 101 of an impactor 100 via a taper lock. See col 7:62-8:3.



In attempting to read the embodiment of Figure 8 onto claim 1, presumably element 91 would be the shaft that defines a shaft axis. No housing extends from the shaft transversely relative to the shaft axis. There is no flange portion that is configured to move relative to a base plate in a direction transverse to the shaft axis between an in-use position and a retracted position.

<sup>1</sup> Peterson reverses the understood orientation of proximal and distal when describing the elements. That is, element 63 is located on the distal end of device 60.

Further, the o-ring 107 of Peterson does not serve to bias anything; it is simply provided to prevent metal on metal contact when impacting the cup. See Peterson, col 8:3-8; col 8:51-57.

Applicants submit that Peterson does not anticipate claim 1, and therefore does not anticipate claims 2-18, which depend from claim 1. Applicants reserve the right to argue further patentability based on the claimed elements of claims 2-18 with respect to Peterson. Applicants request that the Examiner withdraw the rejection.

Claims 1,3-4, 12, and 14 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,540,697 (Rehmann). Applicants traverse the rejection.

As is shown in the figures below, and in the annotated figure from page 6 of the Office Action, Rehmann discloses a cup positioner that relies on pivotable fingers to engage the cup:

the implant engaging means 14 preferably comprises three engaging fingers 26 for engaging a rim groove 28 on the socket implant 20 around its internal circumference. Each of the engaging fingers 26 is connected to the first end 16 of the elongated tool body 12 with a suitable pivot connection 30.

Rehmann, col 5:20-25. As is best shown in Figures 2 and 3, the position of fingers 26 is controlled by hollow outer body 36. When body 36 is disengaged with fingers 26, as shown in Figure 3, below, springs 34 bias fingers 26 to a position where they do not engage with the cup.

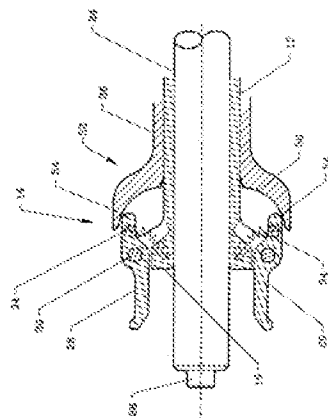
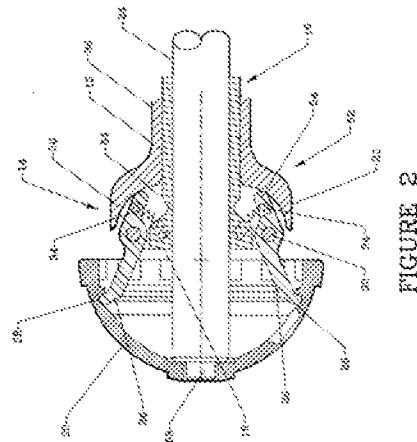


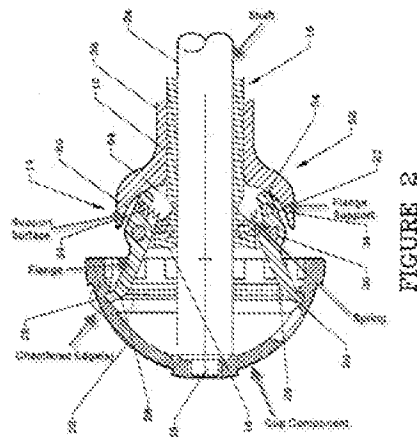
FIGURE 3

When body 36 is engaged with fingers 26, as shown in Figure 2, below, control surface 54 of fingers 26 ride up the curved inner surface 50 of body 36 to pivot fingers 26 about pivot points 30 into engagement with cup 20. See Rehmann, col 6:44-col 7:19.



Thus, absent a force applied by body 36, fingers 26 are biased such that they do not contact the cup 20.

The Examiner states that the movable flange portion (identified as fingers 26 in the annotated figure 2, below) of Rehmann move in a direction parallel to the support. The support is identified as generally as the distal aspect of body 36. Applicants submit that fingers 26 do not move in a direction parallel to the support. Instead, as described in Rehmann, fingers 26 pivot about pivot point 30 and therefore cannot move in a parallel manner.



As a result, Rehmann fails to depict at least the following elements of claim 1:

- a housing attached to the distal end of the shaft, the *housing extending from the shaft transversely relative to the shaft axis*, the housing comprising a base plate;
- the *flange portion being configured to be movable relative to the base plate in a direction transverse to the shaft axis* between an in-use position, where the flange portion is received in the groove of the cup component, and a retracted position where the flange portion is moved towards the shaft axis so as to allow the cup component to be released from the instrument, and wherein the flange portion is biased towards the in-use position.

For at least these reasons, Applicants submit that claim 1 is patentable over Rehmann, and request the withdrawal of the rejection.

Claim 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Petersen (US 5584837) in view of Cohen et al. (US 5571200). Claim 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Petersen (US 5584837) in view of Schroeder (US 6132469). Applicants traverse the rejections. Claims 10 and 13 are patentable at least because they depend from independent claim 1, which as described above is patentable over Peterson. For at least this reason, Applicants request that the rejections be withdrawn.

Please charge any fee required during and in connection with the prosecution of this application to Deposit Account No. 10-0750.

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